



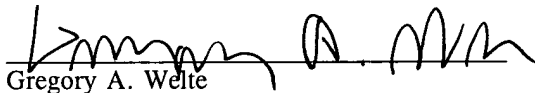
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 9457.00)
Group Art Unit: 3691)
Serial No.: 10/051,355)
Examiner: Siegfried Chencinski)
Filing Date: January 18, 2002)
Title: Self-Service Terminal)

CERTIFICATE OF MAILING

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Gregory A. Welte

REPLY BRIEF

Re: Answer, Pages 1 - 11

No reply needed.

Re: Answer, Page 11, (Answer's Response to Argument A)

The Answer identifies arguments in the Brief as Argument A, B, etc. This Reply identifies those arguments in the same way.

In Argument A, the issue is whether the Specification has support for adding the following underlined phrase which was added to claim 12:

(b) obtaining contact information which enables the ATM to contact a communications device associated with the identified user;

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Reason for Adding the Phrase

Original claim 12 recited "obtaining contact information for a communications device associated with the identified user." For example, the "communications device" may be a telephone, and the "contact information" may be a telephone number. (Specification, page 3, lines 3 and 19 - 23.)

A previous Office Action asserted that a Smith reference shows that.

Smith concerns a computerized dispatching system, for dispatching taxicabs and ambulances, and perhaps cargo-carrying vehicles such as those used by United Parcel Service and Federal Express.

Smith's system handles problems such as

- 1) determining the location of a person who makes a request for transportation, or a pick-up,
- 2) determining the best vehicle to select for that person, based on factors such as the vehicle's location and whether the vehicle has facilities which may be needed by the person, such as a wheelchair lift, and so on.

Thus, Smith may show the phrase "obtaining contact

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information for a communications device," if taken in isolation, because Smith communicates with various parties.

The claim was amended to emphasize that (1) the ATM obtains the "contact information," and (2) the ATM makes the contact, ie, the ATM establishes the communication.

Support for the Amendment

POINT 1

Original claim 12(b) recites an action taken by an SST, Self Service Terminal. (The Specification, page 4, line 10, states that the SST may be an ATM.) Original dependent claim 13 further defines that action. Those claims together state, in part:

12. A method of operating a self-service terminal . . . comprising:

. . . .

b): obtaining contact information for a communications device associated with the identified user

13. A method according to claim 12, wherein step (b) includes the step of:

(b-1) retrieving . . . a telephone number to be called to establish a telecommunications link with the communications device.

THEREFORE, the original claims clearly state that

-- a "telephone number" is "obtained," and

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-- "calling" the "telephone number"
"establishes a telecommunications link with
the communications device."

That is clear support for the language which was added to
claim 12(b), which is the underlined language in this passage:

(b) obtaining contact information which
enables the ATM to contact . . . a
communications device associated with the
identified user.

(The abbreviation "ATM" is present because claim 12 was amended
to recite an ATM instead of an SST.)

That is, the Specification states that the terminal/ATM uses
the telephone number (contact information) to call the telephone
(communications device). That means that the contact information
enables the ATM to contact the telephone.

POINT 2

The Abstract states:

The **terminal** further includes contact means
. . . for contacting the communications
device . . . to allow a transaction to be
entered thereby.

As explained above, the "terminal" can be an ATM.

This clearly supports the claim language of

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(b) obtaining contact information which enables the ATM to contact . . . a communications device associated with the identified user.

The reason is that the Abstract states that the **terminal** uses the **contact means** to **contact** the **communications device**. Thus, the **contact means** "enables" the **terminal** to do so.

POINT 3

As stated above, the Specification states that the "contact information" can be a telephone number, and the "communications device" can be a telephone. If you substitute "telephone" and "telephone number" into the claim phrase, you obtain this:

(b) obtaining a **telephone number** which enables the ATM to contact . . . a **telephone** associated with the identified user.

The issue evaporates. Clearly, the **telephone number** "enables the ATM to contact" the **telephone**.

POINT 4

The Specification, and the original claims, clearly state that the ATM/SST uses the contact information/telephone number to contact the communications device/telephone. Examples supporting this assertion are given below.

Common sense tells you that, **without the telephone number**,

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the ATM **CANNOT** contact the telephone.

Therefore, the Specification, and the original claims, provide support for the concept that the "contact information" (telephone number) "enables the ATM to contact" the "communications device" (the telephone).

The Examples

ONE

The Specification, page 1, lines 18 - 22, states that a self-service terminal ("SST" herein) obtains the "contact information for a communications device."

TWO

The Specification, page 3, lines 19 - 23, states that the "contact information" may be a telephone number.

THREE

Original claim 5 states that an SST (1) obtains a telephone number of a user and (2) establishes a link with the telephone to allow a transaction thereby.

FOUR

Original claim 6 states:

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means for establishing a link with the communications device based upon the obtained contact information to allow the ATM customer to enter an ATM transaction

FIVE

Original claim 7 states that a "means for obtaining contact information" in claim 6 "includes means for retrieving data relating to a telephone number . . . to establish a link with the communications device . . ."

SIX

Original claim 10 recites

means for obtaining a telephone number for a telephone associated with an ATM customer;

means for establishing a link with the telephone based upon the obtained telephone number to allow the ATM customer to enter an ATM transaction.

POINT 5

Applicant points out that **EXACT** terminology is not required.

MPEP 2163.02, near the end, states:

. . . the fundamental factual inquiry is whether a claim defines an invention that is **clearly conveyed** to those skilled in the art at the time the application was filed.

The subject matter of the claim **need not be described literally** (i.e., using the same

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terms or in haec verba) in order for the disclosure to satisfy the description requirement.

This MPEP section continues to state:

Any time an examiner bases a rejection of a claim . . . on the lack of a written description, the examiner should:

(A) identify the claim limitation not described; and

(B) provide reasons why persons skilled in the art at the time the application was filed would not have recognized the description of this limitation in the disclosure of the application as filed.

The Answer fails to comply with this latter MPEP requirement.

Re: Answer, Page 12 (Answer's Response to ARGUMENT B)

Point 1

The Answer is asserting that KSR has over-ruled Graham v. Deere. That is not so.

That is, the Answer is asserting that KSR has stated that the factual inquiry of Deere, in which the claim elements must be shown in the prior art, has been eliminated. That is not so.

KSR merely discussed the type of teaching required in Deere, for combining references.

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Point 2

The passages of KSR cited by the Answer do not support the Answer's assertion that KSR states that all claim elements need not be shown in the prior art.

Those cited KSR - passages merely describe the type of reasoning required to combine and modify references. They do not address the issue of whether all claim elements must be shown in the references.

Point 3

The Answer is asserting that KSR holds that, in an obviousness rejection, the prior art need not show all elements of a rejected claim.

Under the law of stare decisis KSR cannot be cited for such a proposition. The reason is that, in KSR, **all claim elements were present in the references.**

Under the law of stare decisis, a "holding" of a court decision is the chain of logical steps required to reach the conclusion of the decision.

In KSR, as just stated, **all claim elements were present in the references.** There is no need for KSR to state that some elements **NEED NOT** be shown in the references. Nor did KSR state this.

Thus, under the law of stare decisis, KSR does not support

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the Answer's position. There is no need in KSR for a statement that the prior art need not show all claim elements in an obviousness rejection.

Re: Answer, Page 12 (Answer's RESPONSE to ARGUMENT C)

The Answer asserts that it can ignore claim language which is "descriptive" and "non-functional."

Point 1

The MPEP **expressly states** that "functional language" is acceptable. MPEP § 2173.01 states:

Claim Terminology

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.

Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.

As noted by the Court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

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Point 2

The Answer admits that the language in question is "descriptive." A **description** serves as a **definition**, or partial definition. Thus, a description cannot be ignored.

Section 112 states that the claims must "distinctly" claim the invention. "Distinctly" means how the invention is **distinct** from the prior art, or **distinguished** from the prior art. A **description** shows how an invention is "distinct."

Point 3

The Answer asserts that the language in question is "non-functional." That is erroneous.

-- The phrase "which enables the ATM to contact . . ." sets forth a **function** which is accomplished.

-- The phrase "so that a transaction may be executed . . ." sets forth a **result** which is attained. What produces results ? Actions. That is, functions.

Point 4

The Answer cites a Lowry case. However, the facts of Lowry are distinguishable, and Lowry does not hold what the Answer

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asserts.

Further, the principles of Lowry are actually **contrary** to the Answer's position. A Gulack decision, which Lowry cites but does not apply (because Lowry reversed the PTO) states that, if an appropriate "functional relationship" is set forth between "printed matter" and "hardware," then the "printed matter" is part of the claim, and can be used to distinguish over the prior art. The "printed matter" cannot be ignored.

That principle **DOES NOT STATE** that "functional language" can be ignored. In fact, the principle states **the opposite**. The principle states that "functional language" can actually **add** a limitation to a claim. This, and Lowry, will be explained.

LOWRY DECISION

In Lowry, the PTO rejected a claim relating to data in a computer, on the grounds that the data is "printed matter," and the claims did not specify an appropriate relationship between the "printed matter" and the equipment storing the "printed matter."

GULACK DECISION

The PTO's grounds for rejection were based on a Gulack decision. Gulack concerned a series of cylinders on a common axis, each cylinder bearing numbers, like the wheels on a

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mechanical odometer. The cylinders could rotate, so that rows of different numbers could be displayed. The PTO argued that Gulack showed "printed matter" (the numbers) having no "functional relationship" with the cylinders.

The court in Gulack reversed, holding that a "functional relationship" **did exist**, because movement of the cylinders altered the sequences of numbers, producing an infinite combination of sequences.

LOWRY AGAIN

The Court in Lowry held that the computer data **was not** "printed matter." Thus, the data was part of the claim, and could be used to distinguish over the prior art. The principle of Gulack did not apply.

THEREFORE

-- Lowry does not support the Answer's proposition. Lowry does not state that "functional language" and "descriptive" terms can be ignored. Further, Lowry held that the supposed "printed matter" is part of the claim, and can be used to distinguish over the prior art, **BECAUSE** proper "functional language" was used.

Appellant repeats: in Lowry, "functional

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language" actually acted as a **limitation**,
contrary to the PTO's view of Lowry.

-- The Gulack decision, cited by Lowry,
states that, if a proper "functional
relationship" is recited between "printed
matter" and hardware, then the "printed
matter" is part of the claim, and cannot be
ignored. That is **contrary** to the Answer's
position, which is that "functional language"
can be ignored.

Point 5

The Answer cites an Ngai case. That case does not support
the Answer's position.

Ngai concerned a chemical test kit which was known in the
prior art. Ngai added instructions (printed matter) which
instructed a user on how to use the test kit for a new purpose.

The court held that there was no proper functional
relationship between the printed matter and the test kit. The
court stated:

Here, the printed matter in no way depends on
the kit, and the kit does not depend on the
printed matter.

All that the printed matter does is teach a
new use for an existing product.

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As the Gulack court pointed out,

where the printed matter is not
functionally related to the substrate,
the printed matter will not distinguish
the invention from the prior art in
terms of patentability.

36 F.2d 1336, slip opinion at page 5.

Point 6

As Points 5 and 6 indicate, the Lowry and Ngai decisions do not support the Answer's position.

Lowry and Ngai, and cases cited therein, state that **if a proper "functional relationship" is recited** between printed matter and hardware, then the printed matter becomes a limitation, and can be used to distinguish over the prior art.

Lowry, Ngai, and cases cited therein **DO NOT STATE** that "functional language" can be ignored. In fact, they say the **opposite**. They state that "functional language" can create limitations (by adding printed matter as a limitation).

Re: Answer, Page 13 (Answer's RESPONSE to ARGUMENT D)

The Answer merely cites two court decisions, and then sets forth the naked conclusion that the Examiner followed the law.

The Examiner's naked conclusion is insufficient. Evidence is required.

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Re: Answer, Page 13 (Answer's RESPONSE to ARGUMENT E)

The Answer fails to rebut the Brief. The Answer's naked assertion that the rules have been followed is insufficient.

Further, the Answer cites a passage from a McLaughlin decision, the last phrase of which states:

[a rejection can take] into account only
knowledge which was within the [prior art]
and [cannot] include knowledge gleaned only
from applicant's disclosure.

The rejection fails to follow this requirement. The only content of the rejection which is found in the prior art is a five-word phrase in Savage. Since, as the Brief explained, the five-word phrase in Savage shows none of the claimed invention, the rejection relies entirely on Appellant's disclosure. That is not allowed by the Mclaughlin decision.

Re: Answer, Page 14 (Answer's RESPONSE to ARGUMENT F)

The issue is whether Savage or Ahuja show "obtaining a telephone number." Appellant points out that the claims recite specific apparatus which obtains the telephone number, and specific uses of the telephone number, which have not been shown in the references.

Point 1

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The Answer relies on two passages in Ahuja to show "establishing a telecommunications link with the communications device, namely,

- 1) paragraph 38, lines 4 - 6, and
- 2) paragraph 17, lines 4 - 6.

Appellant points out that this does not show obtaining a telephone number.

Further, passage (1) has no relevance whatever to the claimed "communications device." Passage (1) merely refers to ATMs in Ahuja's prior art, which require hard-wired telephone lines in order to function. That does not show the claimed "communications device associated with the user."

Passage (2) merely summarizes one aspect of Ahuja's invention, which involves portable ATMs, which need no hard-wired telephone lines. They use wireless communication for the portable terminals.

The only "communications device" possible in passage (2) is the portable ATM itself. However, that does not show the claimed "communications device associated with the user," or obtaining a telephone number.

Further, claim 1 states that the "ATM" "contacts" the "communications device." Under the Office Action's reading of Savage, the ATM in Savage "contacts" itself. That makes no sense.

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Point 2

The Answer relies on Savage, column 4, lines 15 - 18.
Savage in general discusses an ATM at which customers can execute transactions using the spoken word, via a microphone and loudspeaker, instead of pressing buttons. At the cited location, Savage states:

Other users may choose other voices, or the voice may be selected by the ATM operator.

A user whose account is overdrawn may be advised, in a stern male voice, to immediately contact the relevant financial institution.

(Savage, column 4, lines 15 - 18.)

Plainly, this fails to show obtaining a telephone number.

Point 3

The Answer relies on Ahuja's paragraphs 46 and 47.

Paragraph 46 discusses terminals communicating using wireless telephone service. That does not show obtaining a telephone number.

Paragraph 47 discusses various networks used by terminals for communication. That does not show obtaining a telephone number.

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Point 4

The Answer relies on Ahuja's paragraphs 44 - 50. Those paragraphs discuss various ways in which a terminal uses networks, such as the Internet, to obtain data from a host computer, to display to a customer.

That does not show obtaining a telephone number. Further, the terminals do not use telephone numbers to access the host. They use Internet addresses, or equivalent.

Point 5

The Answer cites Ahuja's Figures 1 and 2. Figure 1 is a block diagram of a network. Figure 2 is a block diagram of a smart card, and its reader.

None of that shows obtaining a telephone number.

Point 6

The Answer relies on Official Notice. The Answer asserts that the Notice has not been traversed.

In response, Appellant points to the Brief, page 43, which states:

Point 3

In response to the invocation of "Official Notice," the undersigned attorney respectfully traverses the Official Notice, and requests a citation of evidence showing

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the Noticed element. (See MPEP § 2144.03.)

One reason is that the Noticed "telephone number" is that of a bank account holder in the prior art.

However, in the combined references (Ahuja and Savage), there is no telephone at which that bank account holder can be reached.

Thus, the Noticed "telephone number" appears irrelevant to the references.

The Answer has failed to cite evidence showing the Noticed subject matter.


Point 7

The Brief addresses the remainder of page 15 of the Answer.

CONCLUSION

Appellant requests that Board overturn the rejections, and pass all claims to issue.

Respectfully submitted,


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